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EXAMINER

REIS, TRAVIS M

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2859

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/881,856
Filing Date: June 13, 2001
Appellant(s): DUNCAN, SUSAN M.

David Lowe
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/2/6 appealing from the Office action
mailed 5/4/6.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Bobrick "Space for people in wheelchairs is a fundamental design consideration" 1993.

Art Unit: 2859

1,625,041	Marshall	2-1926
4,276,695	Stansbury	7-1981
4,250,642	Riehle	2-1981

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A) Claims 1, 14, 19-22, 25, 28, 33-35, 37, & 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick in view of Marshall (U.S. Patent 1625041).

Bobrick discloses a design tool, system & method (see attachment) for use in association with design plans having hallways, doorways, stairways, rooms and other spaces of a known scale, for functional and space planning in the fields of architecture, interior design, and construction of residential and commercial structures (col. 1 lines 29-30 through col. 2 lines 1-9), comprising a two dimensional icon figure member (A) shaped as a human (B) seated in a wheelchair (C) with at least two wheels (D) supporting the chair of the icon figure member, the member having a base (E) engagable with the design plans (see attachment); the icon figure member attached to said base, said base equal to or greater than the diameter of the icon figure member (see attachment), and scaled (F) to indicate a turning radius to imitate & indicate the turning radius of a wheelchair support device (Figure 2) along the hallways, doorways, stairways, rooms and other spaces of the design plan to visually illustrate the feasibility of movement along the noted paths in light of the size and turning radius of the represented person.

Art Unit: 2859

Bobrick does not disclose the icon figure member is a three-dimensional figure with a three-dimensional base extending downwardly and outwardly from said three-dimensional figure.

Marshall discloses a device including a chart device & means which utilize three-dimensional figures including various types of persons (30-32, 36) (Figures 3, 6, & 11) with three-dimensional bases extending downwardly and outwardly from said persons (X, see below)



(page 2 lines 67-69). These figures are scaled to represent the proportionate relationship between objects (i.e. people, cars, etc.) within the chart device. Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to shape the icon figure member figure (A), shaped as a wheelchair or a human seated in a wheelchair with the peripheral edge shaped to coincide with a scaled space envelope desired for movement of a wheelchair, as disclosed by Bobrick into a three dimensional figure, with the turning radius (G) disclosed by Bobrick becoming a base extending downwardly and outwardly, as taught by the various three dimensional persons set upon bases disclosed by Marshall in order that the height of fixtures in the design plan are properly considered, the need for which is demonstrated in Figure 1 of Bobrick, and since Marshall already suggests using 3D figures to convey information to a user.

Art Unit: 2859

B) Claims 3-6, 8, 9, 11-13, 15, 16, 18, 22, 26, 31, 32, & 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick & Marshall as applied to claims 1, 14, 19-22, 25, 28, 31-35, 37, & 38 above and further in view of Stansbury (U.S. Patent 4276695).

With reference to claims 3, 8, 9, 11, 15, 16, 26, 31, & 32, Bobrick & Marshall disclose all of the instant claimed invention as stated above in the rejection of claims 1, 14, 19-22, 25, 28, 33-35, 37, & 38 but do not disclose a wand member with a first and second end extending from the icon figure member at any angle relative to the perpendicular, from an opening in the icon figure member wherein a first end of the wand member is maintained within the opening by frictional contact or a snap lock combination.

Stansbury discloses a roller measure device (30) with an opening (101) with a wand/handle member (44) wherein the wand/handle member is held within the opening by frictional contact in order to push the device around easily and move it forward along a surface (Abstract; col. 6 lines 48-50) (Figure 5). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the opening and wand/handle member disclosed by Stansbury to the icon figure member disclosed by Bobrick & Marshall in order to pick up, place, turn, and move the icon figure member forward along the surface of the plans more easily and with better control by the act of gripping the wand/handle member instead of reaching and gripping the icon figure member itself.

Art Unit: 2859

With reference to claims 11 & 18, Bobrick & Marshall do not disclose first and second ridges along the opening and wand/handle member respectively to provide a snap lock combination.

Stansbury also discloses other types of connection means including snap lock combinations between two ridges (172, 173) on two pieces (52) of the wand/handle member (Figure 5).

Stansbury discloses other types of connection means including a connection means between two ridges (172, 173) on two pieces (52) of the wand/handle member that form a snap lock combination when placed together (Figure 9). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the ridge member disclosed by Stansbury to the opening and end of the wand/handle member disclosed by Bobrick & Marshall in order to have a snap lock combination, in order that the handle is securely connected to the design tool and since a snap lock combination is an common alternative means of connection.

C) Claims 10 & 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bobrick, Marshall, & Stansbury as applied to claims 3-6, 8, 9, 11-13, 15, 16, 18, 22, 26, 31, 32, & 36 above, and further in view of Riehle (U.S. Patent 4250642).

Bobrick, Marshall, & Stansbury disclose all of the instant claimed invention as stated above in the rejection of claims 3-6, 8, 9, 11-13, 15, 16, 18, 22, 26, 31, 32 & 36 but do not disclose a metal plate located in the opening, and a magnet in the end of the wand/handle member, thereby providing a plate-magnet combination.

Art Unit: 2859

Riehle discloses a planning aid and that metal plates and magnetic planning elements connecting to said plates are common in the art (col. 1 lines 30-34). Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention was made to add the metal plate and magnet disclosed by Riehle to the design tool disclosed by Bobrick, Marshall, & Stansbury in order to provide a strong, but easily releasable connection means, and since a magnet and metal plate combination is an common alternative means of connection.

(10) Response to Argument

Issue I: Group 1 arguments.

In response to applicant's arguments against the references individually (i.e. that Bobrick is not three-dimensional and Marshall has only rectangular bases), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's arguments that Bobrick does not suggest a three dimensional member and base would provide a superior means for assessing the location of design elements; these arguments have been fully considered but they are not persuasive since Figure 1 of Bobrick shows that the need for height considerations in design elements are to be considered.

In response to applicant's arguments that there is no suggestion in Marshall that the bases should have "a peripheral edge shaped to coincide with a scaled space envelope desired for movement of a wheelchair to visually illustrate the feasibility of

Art Unit: 2859

movement of the wheelchair in a space represented by a design plan"; these arguments have been fully considered but they are not persuasive since Bobrick already teaches "a peripheral edge shaped to coincide with a scaled space envelope desired for movement of a wheelchair to visually illustrate the feasibility of movement of the wheelchair in a space represented by a design plan", while the bases of Marshall teaches that such an edge as disclosed by Bobrick can be three dimensional.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Bobrick and Marshall teach the use of iconic figures in scale models and this combination is clearly stated in paragraph 2 of the final office action. That the Marshall icons are used primarily for incident recreation does not preclude the reference from teaching the use of three-dimensional figures to convey information to a user. The suggestion that representational icon figures may be shaped in three dimensions, as disclosed by Marshall, is what is being used to modify the icons in the design plans, already entailing the features of functional and space planning (i.e. hallways, doors, etc.) to accurate scale, including a turning radius to imitate the turning radius of a support device by using a figure shaped as a human seated in a wheelchair, as disclosed by Bobrick, and

Art Unit: 2859

therefore the combination is proper. Furthermore, Bobrick also denotes the recognition of the utility of a third dimension in icon figures illustrated in Figure 1, wherein height, besides turning radius, is considered.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Issue II: Group 2 arguments.

In response to applicant's arguments against the references individually (i.e. that Bobrick is a thin flexible template; Marshall only teaches placement of models), one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's arguments that there is no indication in any of the references to any benefit to be obtained by securing a handle to the models taught by Bobrick & Marshall; these arguments have been fully considered but they are not

Art Unit: 2859

persuasive since the models disclosed by Bobrick and Marshall are more easily manipulated and moved along a surface, as taught by Stansbury.

In response to applicant's argument that there is no suggestion to combine the references of Stansbury with Marshall & Bobrick, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the handle disclosed by Stansbury move a device forward along a surface, the teaching of which would be an advantageous feature to the small figures disclosed by the combination of Bobrick & Marshall, which helps to bring a figure "in position" as Applicant admits in pg. 11, line 21 of the Remarks of the amendment filed 2/16/2006. Furthermore, with such a handle would provide an easier, more controllable, means of turning the figure along its axis than merely reaching and gripping the figure to turn said figure.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

Art Unit: 2859

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Issue III: Group 3 arguments.

In response to applicant's arguments to claims 10 & 17; these arguments have been fully considered but they are not persuasive for the reasons presented above.

Issue IV: Group 4 arguments.

In response to applicant's arguments that neither Bobrick or Marshall disclose movement; these arguments have been fully considered but they are not persuasive since Figure 2 of Bobrick makes use of arrow notation to denote movement; and Figure 1 of Marshall displays arrows and dashed lines denoting movement during the reproduction of events (pages 2 right col. lines 125-131 through page 3 left col. lines 1-5).

Issue V: Secondary Consideration arguments

In response to applicant's arguments that the opinions and facts alleged in the affidavits are not evidence of nonobviousness; these arguments have been fully considered but they are not persuasive since there is no evidence beyond the declarations provided, and while the declarations are given consideration, are not alone sufficient evidence.

In response to applicant's arguments that the Declarations provide proper evidence showing commercial success; these arguments have been fully considered but they are not persuasive since no objective evidence is provided to support Declarant's statement that the "commercial success" was of the patented invention

Art Unit: 2859

itself. The declarations only provide statements without any evidence (i.e. sales records, receipts, etc.) supporting these Statements. While the Declarations are given consideration, declarations alone are not sufficient to prove commercial success.

In response to applicant's arguments that the Declarations provide proper evidence showing the long-felt need; these arguments have been fully considered but they are not persuasive since none of the Declarations provide any objective evidence of the date that the need arose; objective evidence of the date of the articulation of the problem; objective evidence that the problem was a persistent need in the industry; objective evidence that prior attempts in the industry by others did not satisfy the need; or objective evidence that the need was satisfied by applicant's invention. The declarations only provide statements without any evidence supporting these statements. While the Declarations are given consideration, declarations alone are not sufficient to prove long felt need.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2859

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

tmr

December 6, 2006

Conferees:

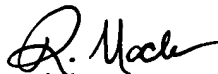
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